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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,718	04/04/2001	Yoji Furuya	36409-01100	3164

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1 Chase Manhattan Plaza  
New York, NY 10005

EXAMINER

POND, ROBERT M

ART UNIT PAPER NUMBER

3625

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/825,718

Applicant(s)

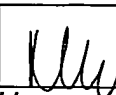
FURUYA, YOJI

Examiner

Robert M. Pond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Response to Amendment***

The Applicant amended Claims 1, 2, 4, 8-12, 14, 15, 17,18, 22, and 24-30. All pending claims (1-30) were examined in this final Office Action necessitated by amendment.

### ***Response to Arguments***

#### **Rejection under 35 USC 102(e)**

The Applicant amended claims and based arguments on the amended claims to overcome rejection under 35 USC 102(e). Applicant's arguments filed 09 August 2004 have been fully considered but they are not persuasive. The Applicant argues:

- *Chihara fails to disclose or suggest that the output device is connected to the information processing device on the user side via a first or local connection.*

Rejection under 35 USC 102(e) has been withdrawn in light of the amended claims. Chihara (Paper #4) in view of Machine Design (Paper #4, prior art of record but not previously relied upon) teach a user-side computer having a first or local connection.

- *and, further is connected to the information processing device on the supplier side via a second or network connection.*

Chihara and Machine Design teach or suggest an output device with a first connection having a second connection being a network connection over the Internet.

Rejection under 35 USC 103(a)

Applicant's arguments filed 09 August 2004 have been fully considered but they are not persuasive. Rager teaches the memory being erased in the event that the device is tampered with or powered down.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1, 2, 5-12, 15, 18-22, and 25-30 are rejected under 35 USC 103(a) as being unpatentable over Chihara (Paper #5, patent number 6,208,428), in view of Machine Design (Paper #5, PTO-892, Item: W).**

Chihara teaches a system for outputting data selected by user-side to an information processing device on a supplier-side. Chihara further teaches:

- Output device including data request means: a printer (see at least Fig. 1 (7); Fig. 2 (16); Fig. 7 (2); col. 1, lines 9-57; col. 5, lines 52-67).

- Information processing device (supplier side): a server computer (see at least col. 5, lines 52-67).
  - i. Determination means: inherent in Chihara is determination means of the type of output device connected (please note: uses bi-directional communication cable connecting to higher ranked device's printer status monitor, printer setting request monitor, and printer data transmission monitor) (see at least Fig. 2 (15, 16, 17, 100); Fig. 7 (100); col. 7, lines 48-65).
  - ii. Controller for controlling transmission of data to output device: (see at least Fig. 1 (70); Fig. 2 (1); col. 1, lines 24-26).
- Information processing device (user side): producer client computer (col. 5, lines 52-67).
- Output device communications: output device connects to supplier-side information processor independent of user-side information processor (see at least Fig. 7 (2); col. 11, lines 20-26).
- Output device transmission means for sending charge information: transmits charging information; charging information storage means (see at least title; Fig. 1 (76); col. 1, lines 14-57; col. 2, lines 23-36).
- Information processing device recognized the output device: store data of the status and construction of the printer (see at least col. 5, lines 30-31, 60-61).

- Predetermined functionality: printing with charge control program as noted above.
- Identifiers: identifies each producer; means for recognizing every producer (see at least col. 1, lines 62-63; col. 2, lines 14-15).
- Output device request reception means from information processing device; receives data: prior to transfer of data, send print control code that causes the printer to notice the total print number; higher ranking computer transmits printing commands (see at least Fig. 3 (S5, S6); col. 9, lines 20-34).
- Storage means: (see at least Fig. 1 (75, 76); Fig. 2 (14, 18 21, 22)).
- Output device including a first connection means for connecting to an information processing device on a user side.

Chihara teaches all the above as noted under the 103(a) rejection and teaches a) a computer as a higher ranking device than an output device (e.g. a printer), b) a higher ranking device computer connected to a printer using a bi-directional communications cable (please note: a first connection means) (Fig. 2 (100)), c) a user-side computer connected to a supplier-side computer over a network (please note: a second connection means) (Fig. 7 (3, 4, 110)), d) the supplier-side computer as a higher ranking device than a printer connected to a printer with a bi-directional communications cable (please note: identical connection means as first connection means) (Fig. 7 (2, 3, 100)), and e) a user-side computer and a

supplier-side computer as higher ranking devices than a printer (Fig. 7 (2, 3, 4)). Chihara, however, does not disclose the user-side computer having a first connection means to an output device. Machine Design teaches an Internet printing system that is fully integrated with standard operating systems that allows sending print jobs to printers connected to the Internet. Machine Design teaches sending print jobs to a personal printer attached to a personal computer connected to the Internet. Machine Design further teaches the user-side computer having a direct connection to the personal computer's parallel or serial port. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system of Chihara to disclose a user-side computer connected to a network to have a first connection to a printer as taught by Machine Design, in order to support local user-side printing by users.

- *a second connection means for connecting to an information processing device on the supplier side.*

Chihara and Machine Design teach all the above as noted under the 103(a) rejection and teach a) user-side printers having a direct connection to a user-side computer that is connected to the Internet, b) sending print jobs to printers connected to the Internet or a personal printer attached to a PC (please note examiner's interpretation: printer has it's own Internet connection), c) printers connected directly to the Internet receiving print jobs without the need for spooling on a file server, and further teach

printing across the Internet avoids the need to send large e-mail attachments which rely on the receiver having an appropriate application for printing (please note examiner's interpretation: a benefit to the user) (W: see page 1), but do not disclose a printer with a first connection means having a second connection means. It would have been obvious to one of ordinary skill in the art at time of the invention to disclose a printer with a first connection means having a second connection means, since one of ordinary skill in the art would ascertain that a user-side printer with a first connection and a second connection offers users more benefit than two printers-one directly attached to a computer and the other printer connected to the Internet, and thereby attract users to a single printer that supports both connections.

Pertaining to storage medium Claims 28-30

Rejection of Claims 28-30 is based on the same rationale as noted above.

2. **Claims 3, 4, 13, 14, 16, 17, 23, and 24 are rejected under 35 USC 103(a) as being unpatentable over Chihara (Paper #5, patent number 6,208,428) and Machine Design (Paper #5, PTO-892, Item: W), as applied to Claims 1, 2, 10, 11, 15, and 22, in view of Rager et al. (Paper #5, patent number 5,363,447, hereinafter referred to as "Rager").**

Chihara and Machine Design teach all the above as noted under the 103(a) rejection and teach a) storing charging information in memory, b) storing print



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data, and c) deleting information, but do not disclose deleting information upon detecting a power-off condition. Rager teaches erasing memory to maintain data security in the event that a device is tampered with or powered down (see at least col. 1, lines 64-67; col. 4, lines 37-49). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Chihara and Machine Design to include power-off detection and data deletion as taught by Rager, in order to provide tamper-proof data protection of chargeable print data, and thereby attract data suppliers to the service.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

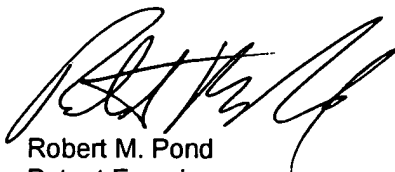
***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:

**703-872-9306** (Official communications; including After Final communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

A handwritten signature in black ink, appearing to read 'R. M. Pond', is written over the printed name.

Robert M. Pond  
Patent Examiner  
November 15, 2004